REMARKS

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

In paragraph 4 of the Advisory Action dated Mary 24, 2007, Claims 36 and 42 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter based upon the Examiner's belief that "the claims contain multiple transition phrases.'

As far as the rejection is understood, Applicant submits that the rejection is overcome by the amendments of independent Claims 36 and 42 herein to include a carriage return following the transition phrase "comprising."

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, 2nd PARAGRAPH

In paragraph 7 of the Advisory Action, independent Claims 6, 12, 21, 36 and 42 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention based upon the inclusion of the word "any" in the claims. In response, Applicant has amended each of the independent claims to remove the word "any" and accordingly submits that the rejection of the claims under 35 U.S.C. § 112, second paragraph, is overcome.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In paragraph 9-11 of the Advisory Action, independent Claims 6, 12, 21, 36 and 42 are rejected under 35 U.S.C. 103(a) as unpatentable over the combination of U.S. Patent No. 5,604,895 to *Raimi* and U.S. Patent No. 4,821,178 to *Levin*. That rejection is respectfully traversed insofar as it might be applied to the present claims.

Applicant respectfully submits that exemplary Claim 6 is not rendered unpatentable by the combination of cited references because that combination does not disclose, teach or suggest each claimed feature. For example, the combination of *Raimi* and *Levin* does not disclose, teach or suggest the following features of exemplary Claim 6 as amended:

a trace array declaration conforming to predetermined syntax, said trace array declaration containing at least:

a keyword declaring existence of a trace array within the instrumentation entity; and

an indication of a monitored signal set including at least one signal among the plurality of signals; and

Applicant has carefully reviewed the references and notes that no such trace array declaration is disclosed therein. Because the combination of *Raimi* and *Levin* does not disclose, teach or suggest each claimed feature, Applicant respectfully submits that the rejection of exemplary Claim 6 as unpatentable under 35 U.S.C. § 103 is overcome.

The foregoing remarks made with respect to exemplary Claim 6 also overcome the rejections of similar independent Claims 21 and 36.

Applicant also respectfully submits that exemplary Claim 12 is not rendered unpatentable by the combination of cited references because that combination does not disclose, teach or suggest each claimed feature. For example, the combination of *Raimi* and *Levin* does not disclose, teach or suggest the following features of exemplary Claim 12 as amended:

… wherein the trace array is further logically coupled to receive a control signal among the plurality of signals;

… wherein recording trace data includes recording, within the trace array, values assumed by the monitored signal set during only those cycles of functional operation during which the control signal is asserted and refraining from recording values assumed by the monitored signal set during those cycles of functional operation during which the control signal is not asserted.

In the last Office Action dated March 20, 2007, the Examiner asserted that the use of the claimed control signal is inherently disclosed by "the power input [because] when power is asserted (provided) the values are stored." Applicant respectfully traverses the assertion of inherency because a "power input" is not logically coupled to a trace array as claimed. In addition, a design entity that is powered off does not have "cycles of functional operation during which the control signal is not asserted," as explicitly set forth in exemplary Claim 12. Because the combination of *Raimi* and *Levin* does not disclose, teach or suggest each claimed feature,

recited in Claim 12 Applicant respectfully submits that the rejection of exemplary Claim 12 as unpatentable under 35 U.S.C. § 103 is overcome.
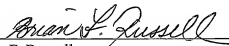
The foregoing remarks made with respect to exemplary Claim 12 also overcome the rejections of similar independent Claims 27 and 42.

CONCLUSION

Having demonstrated how the language of the present claims overcomes each outstanding rejection, Applicant respectfully submits that all pending claims are now in condition for allowance and respectfully requests such allowance.

No additional fee is believed to be required. If, however, any additional fees are required, please charge those fees to IBM Corporation Deposit Account No. **09-0447**.

Respectfully submitted,

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